

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte HEINRICH KISLINGER

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Appeal No. 97-2612  
Application 08/392,766<sup>1</sup>

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HEARD: July 14, 1999

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Before CALVERT, FRANKFORT and SCHAFER, Administrative Patent Judges.

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<sup>1</sup> Application for patent filed January 30, 1995. According to appellant, the application is a National stage application under 35 U.S.C. § 371 of PCT/EP93/01827 filed July 13, 1993.

Appeal No. 97-2612  
Application 08/392,766

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 10 to 17, 24, and 32 to 38.

The appealed claims are drawn to a cutter head with at least one interchangeable cutting blade, and (except for claim 24) are reproduced in the appendix of appellant's brief.

The references applied in the final rejection are:

Caumette et al. (FR) 1980 <sup>2</sup>	2,443,318 (French Application)	July 4,
Biason et al. (EPA) 1989 <sup>3</sup>	345,570 (European Patent)	Dec. 13,

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<sup>2</sup> A translation of this reference was filed by appellant on June 27, 1996.

<sup>3</sup> A translation of this reference, prepared for the Patent and Trademark Office, is enclosed herewith.

Appeal No. 97-2612  
Application 08/392,766

Claims 10 to 17, 24, and 32 to 38 stand finally rejected under 35 U.S.C. § 103 as unpatentable over FR in view of EPA.

The basis of the rejection is set forth on pages 3 and 4 of the examiner's answer, and need not be repeated here.

After fully considering the record in light of the arguments presented in appellant's brief and reply brief, and in

the examiner's answer, we conclude that the claims on appeal are patentable over the combination of FR in view of EPA, and will not sustain the rejection.

It is well settled that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), citing In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In the present case, the examiner asserts that it would have been obvious "to have modified

the concave/convex bearing arrangement of FR with a flat bearing surface, like that taught by EPA, so as to allow for the installation of cutting blades without chip breakers (e.g., concave surfaces) for cutting applications such as wood and composite materials" (answer, pages 3 to 4). However, it is not evident why one of ordinary skill would want to install blades without chip breakers, and the examiner does not identify, nor do we find, any teaching or suggestion in the applied prior art of the desirability of such a feature. While the clamping of a cutter blade between flat surfaces is known, as disclosed by EPA, we find no teaching or suggestion in the prior art which would have

motivated one of ordinary skill to employ such flat surfaces on

the blade 7 and clamp 8 of FR instead of FR's cylindrical bearing surface 12 on the clamp and concave face on the cutter blade. Absent evidence of a suggestion to combine, the rejection cannot be maintained.

#### Conclusion

Appeal No. 97-2612  
Application 08/392,766

The examiner's decision to reject claims 10 to 17,  
24, and 32 to 38 is reversed.

REVERSED

	IAN A. CALVERT	)	
	Administrative Patent Judge	)	
		)	
		)	
PATENT		)	BOARD OF
	CHARLES E. FRANKFORT	)	APPEALS AND
	Administrative Patent Judge	)	INTERFER-
ENCES		)	
		)	
		)	
	RICHARD E. SCHAFER	)	
	Administrative Patent Judge	)	

IAC:psb

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Application 08/392,766

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